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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,542	03/11/2004	Carol B. Jessup	END920030113US1	7836
30400 7590 09/18/2008 HESLIN ROTHENBERG FARLEY & MESITI P.C. 5 COLUMBIA CIRCLE ALBANY, NY 12203			EXAMINER PATs, JUSTIN	
			ART UNIT 3623	PAPER NUMBER
			MAIL DATE 09/18/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/799,542	<b>Applicant(s)</b> JESSUP ET AL.	
	<b>Examiner</b> JUSTIN M. PATS	<b>Art Unit</b> 3623	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3-11-04</u> .   | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 3623

**DETAILED ACTION**

***Notice to Applicant***

1. The following is a non-final, first office action responsive to applicant's communication of 3/11/04. Claims 1–20 are pending in this application and have been rejected below.

Information Disclosure Statement (IDS) dated 3/11/04 has been considered.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1–20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitacre et al., U.S. Pat. Pub. No. 2004/0138944 [hereinafter Whitacre].

4. As per claim 1, Whitacre teaches a method of assessing a project comprising: identifying multiple possible root causes of trouble for a project (§ 0086); identifying questions sets for the multiple possible root causes of trouble (§ 0087–88); evaluating answers to the question sets and provide guidance regarding existence of one or more root causes of trouble for project from the identified multiple possible root causes of trouble (§ 0086, “The following is a list of tools that can help determine the root cause: Brainstorming, Cause and effect analysis (fishbone diagram), Histogram, Graphs, Pareto diagrams, and Checklists.).

Whitacre does not explicitly teach wherein the project is one of product development, or where the tools are computer-implemented. Regarding the type of project being one of product development, this constitutes nonfunctional descriptive material and should not be given patentable weight. The type of a particular project, without positive functional recitation as to its distinctive use, amounts to mere labeling of data and does not functionally alter the method of assessing a project. See MPEP 2106.01 [R-5]. Nonfunctional descriptive material cannot lend

Art Unit: 3623

patentability to an invention that would otherwise have been anticipated by the prior art. When descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability (*see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)). Thus, this further purported limitations of claim 1 fails to further limit the invention as claimed.

Regarding computer-implementation, Whitacre teaches this functionality, especially as applied in its computer-implemented employee scorecard and dashboard tools (Figs. 1, 3–4, and 14; ¶ 0030, discussing the reporting tool functionality). Applying the known technique of computer implementation to a known device, the root-cause tools, ready for improvement, would have been obvious to one having ordinary skill in the art at the time of the invention to achieve a predictable result and result in an improved system that produces results more expediently with less effort and thus saves the user significant time and resources. Moreover, merely providing an automatic means, namely a computer and its standard components, operating a computer program embodied on a computer readable medium, to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

5. As per claim 2, Whitacre teaches evaluating project management processes employed for the project by comparison thereof to identified, standard project management processes (¶ 0088, “c) Does the Team Member know that the performance is less than satisfactory (e.g., feedback given to team member, team member aware of unsatisfactory performance)? If yes, consider the

Art Unit: 3623

basis for how you know the team member is aware that his performance is less than satisfactory. Else, provide appropriate feedback to the team member. (d) Does the Team Member know what is supposed to be done and when (i.e., objectives and standards been defined and mutually agreed upon and clearly stated)? If yes, how do you know the Team Member knows what is suppose to be done and when? Else, set clear goals, objectives and standards with the Team Member to clarify expectations.”), and wherein the tool provides guidance regarding effectiveness of implementation of the project management processes employed for the project (*id.*; *see also* ¶ 0086). As per product development and computer-implementation, see the rejection of claim 1.

6. As per claim 3, Whitacre teaches evaluating project management work product of the project and inputting work product assessment to the tool as further evidence of the existence of the one or more root causes of trouble for the product development project or the effectiveness of implementation of the project management processes employed for the project (¶ 0088, “a) Is there a performance gap (i.e., basis, difference from target)? If so, what is the performance gap? Else, no further analysis required.”). As per product development and computer-implementation, see the rejection of claim 1.

7. As per claim 4, Whitacre teaches an automated scoring mechanism (Fig. 3, Employee Scorecard) but does not explicitly apply it to the root-cause analysis tool. Applying the known technique of automated scoring to a known device, the root-cause analysis tool, ready for improvement, would have been obvious to one having ordinary skill in the art at the time of the

Art Unit: 3623

invention to achieve a predictable result and result in an improved system that produces easily decipherable results in a more expedient fashion thus saving the user significant time and resources. As per product development and computer-implementation, see the rejection of claim 1.

8. As per claim 5, identifying in the tool project personnel roles to answer questions of the question sets (“¶ 0086, “(a) Enlist individuals to help in the root cause analysis. Include individuals that are directly affected by the outcome of the actions to be taken (e.g., Subject Matter Expert, another Team Leader/or an Operations manager”; ¶ 0088, discussing questions given by team leader or other interested individual regarding team members performance and project circumstance). Whitacre does not explicitly teach wherein the question sets also reside in the computer-implemented tool. However, storing project performance management data in a computer implemented tool was old and well known in the art as evidenced at least by Whitacre (¶ 0030, Fig. 1, ref. 12, Consolidated-Reporting Database).

Because each individual element and its function are shown in the prior art, albeit in different references or embodiments, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself—that is in the substitution of question sets for the reporting data of Whitacre. Thus, the simple substitution of one known element for another producing a predictable result renders the claim obvious.

9. As per claim 6, Whitacre does not explicitly teach wherein the product development

Art Unit: 3623

project comprises one of a software development project or a hardware development project.

Regarding the type of project, this constitutes nonfunctional descriptive material and should not be given patentable weight. The type of a particular project, without positive functional recitation as to its distinctive use, amounts to mere labeling of data and does not functionally alter the method of assessing a project. See MPEP 2106.01 [R-5]. Nonfunctional descriptive material cannot lend patentability to an invention that would otherwise have been anticipated by the prior art. When descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability (*see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)). Thus, this further purported limitations of claim 6 fails to further limit the invention as claimed.

10. Claims 7, 8–14, and 15–20 recite limitations that stand rejected via the art citations and rationale applied to claims 1, 1–7, and 1–6, respectively, as discussed above.



***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Litt, *The Many Faces of Troubleshooting and Problem Solving*, Troubleshooting Professional Magazine, Dec 2000, pg. 1–48 (especially pg. 11–13, discussing Root Cause Analysis).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUSTIN M. PATS whose telephone number is (571)270-1363. The examiner can normally be reached on Monday through Friday, 8:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on 571-272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/799,542  
Art Unit: 3623

Page 9

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Examiner, Art Unit 3623

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Primary Examiner, Art Unit 3623